

Notice of Allowability

Application No.

10/639,613

Examiner

James Goloboy

Applicant(s)

LI ET AL.

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the response filed 11/8/07.
2. ☒ The allowed claim(s) is/are 1,4-17,19,20 and 74.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

In claim 19, replace "The method of claim 18" with "The method of claim 1".

This amendment gives claim 19 its proper dependency. Claim 18 was cancelled earlier in prosecution, and its subject matter was incorporated into claim 1. No new matter is added by this amendment.

Authorization for this examiner's amendment was given in a telephone interview with Amy Hoffman on 1/18/08.

Statement of Reasons for Allowance

2. Applicant's arguments filed 11/8/07 are persuasive with respect to the Li reference discussed in paragraph 8 of the office action mailed 8/6/07. The reference has the same inventors as the current application. Therefore, the reference is not "by another" and not eligible as prior art under 35 USC 102(e). The rejection over Li is overcome.

While the examiner disagrees that the currently presented claims are entitled to a the filing date of Application No. 09/441,881 (November 17, 1999), because the '881 application discloses a substantially non-aqueous lubricant containing less than about 5% by weight of water, while the current claims recite a lubricant comprising about 5%

to about 50% by weight of water, the portions of the Person Hei reference discussed in paragraph 7 of the office action mailed 8/6/07 are not entitled to the filing date of the '881 application for the same reason. The subject matter of both the current claims and the Person Hei reference are both supported by Application No. 09/595,835 (now US Pat. No. 6,427,826), with a filing date of June 16, 2000. The Person Hei reference is therefore disqualified as prior art and the rejection over Person Hei is withdrawn.

Approved terminal disclaimers have been filed for all double patenting rejections.

Despo (U.S. Pat. No. 5,391,308) discloses the use of an emulsion to provide lubrication of containers (PET bottles) on conveyors, but does not teach or suggest a silicone emulsion or the formation of a continuous thin film and an unlubricated margin on the conveyor. Shonebarger (U.S. Pat. No. 3,937,676) teaches a silicone emulsion (Silicone 4010) as "standard" for use in glassware, but does not disclose the water content of the emulsion, nor does Shonebarger teach or suggest forming a continuous thin film on a conveyor.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James C. Calogay
JCG


Glenn Caldarcia
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